

BEST AVAILABLE COPY

RECEIVED
CENTRAL FAX CENTERIBM CORPORATION
INTELLECTUAL PROPERTY LAW DEPARTMENT
11400 BURNET ROAD
AUSTIN, TEXAS 78758
FAX # 512

JUL 13 2005

DATE: 7/13/05Number of Pages to Follow (including cover sheet) 8

SEND TO

United States Patent Office

Examiner:

A. M. Lezak

Group Art Unit:

2143

Tel No:

571-272-3916

Fax #:

571 703-872-9306

FROM:

J. B. KRAFT

Tel No:

512- 473-2303

THIS MESSAGE IS INTENDED ONLY FOR THE USE OF THE INDIVIDUAL OR ENTITY TO WHICH IT IS ADDRESSED, AND MAY CONTAIN INFORMATION THAT IS PRIVILEGED, CONFIDENTIAL AND EXEMPT FROM DISCLOSURE UNDER APPLICABLE LAW. IF THE READER OF THIS MESSAGE IS NOT THE INTENDED RECIPIENT, OR THE EMPLOYEE OR AGENT RESPONSIBLE FOR DELIVERING THE MESSAGE TO THE INTENDED RECIPIENT, YOU ARE HEREBY NOTIFIED THAT ANY DISSEMINATION, DISTRIBUTION OR COPYING OF THIS COMMUNICATION IS STRICTLY PROHIBITED. IF YOU HAVE RECEIVED THIS COMMUNICATION IN ERROR, PLEASE NOTIFY US IMMEDIATELY BY TELEPHONE AND RETURN THE ORIGINAL MESSAGE TO US AT THE ADDRESS ABOVE VIA THE U.S. POSTAL SERVICE. THANK YOU.

Docket No. AUS92000025051 Serial No. 09/01, 614 Atty: J. B. KRAFT

Applicant:

G. F. McBrearty et al

- | | |
|---|---|
| <input checked="" type="checkbox"/> Transmittal Letter (2 copies) | <input type="checkbox"/> Certificate of Facsimile |
| <input type="checkbox"/> Preliminary Amendment | <input type="checkbox"/> Notice of Appeal |
| <input checked="" type="checkbox"/> Amendment AF | <input type="checkbox"/> Appeal Brief (3 copies) |
| <input type="checkbox"/> Ext. of Time | <input type="checkbox"/> Reply Brief |
| <input type="checkbox"/> IDS Statement | <input type="checkbox"/> Change of Address |
| <input type="checkbox"/> Other <u> </u> | |

Deposit Acct. No.

09-0447Fees: Amendment ☐ Notice of Appeal ☐ Appeal Brief ☐ Other ☐

BEST AVAILABLE COPY

BEST AVAILABLE COPY

PATENT
09/801,614

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: : Group Art Unit: 2143
Gerald F. McBrearty et al. : Intellectual Property
Serial No: 09/801,614 : Law Department - 4054
Filed: 03/08/2001 : International Business
Title: PROTECTING CONTENTS : Machines Corporation
OF COMPUTER DATA FILES FROM : 11400 Burnet Road
SUSPECTED INTRUDERS BY : Austin, Texas 78758
PROGRAMMED FILE DESTRUCTION : Customer No. 32,329
Date: 7/13/05 :

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence including the present Response after Final Rejection and accompanying Transmittal letter is being transmitted via facsimile to USPTO, Group Art Unit 2143 at telephone number 703-872-9306, and to the attention of Examiner A. M. Lezak on

7/13/05J.B. KRAFT

Signature

Date

7/13/05

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE AFTER FINAL REJECTION

Sir:

The Examiner is respectfully requested to reconsider the Final Rejection of claims 1, 4, 5, 7, 10, 13, 14, 17, 20, 21, 24, 25, 27, and 30 as being unpatentable under 35 U.S.C. 103(a) over the combination of Schneck (US5,933,498) in view of Groshon (US6,351,811). These two references,

AUS920000935US1

1

BEST AVAILABLE COPY

BEST AVAILABLE COPY

PATENT
09/801,614

neither singly or in combination suggest the specific implementation of the present invention for such data protection.

The present invention involves the recognition that in some systems, the data files may be so sensitive that the system may be programmed to have the requested files destroyed at the first unauthorized request for access to the file contents. Thus, the invention provides a very aggressive solution to the problem. It provides for storing for each of the plurality of data files at a network site, a backup file which is inaccessible to any user requests. Then, as soon as an initial unauthorized intrusion is determined, the requested data files are destroyed, and respective stored backup files are substituted for the destroyed files.

Representative claim 1 covers this novel combination of both elements:

"1. (currently amended) In a data processing operation having stored data in a plurality of data files, a system for protecting said data files from unauthorized users comprising:

means for storing for each of said plurality of data files, a backup file inaccessible to user requests;

means for receiving user requests for access to data files;

means for determining whether said requests are unauthorized intrusions into said requested data files;

means responsive to an initial determination that a request is unauthorized for destroying the requested data files; and

means for reloading a backup file for each destroyed file."

AUS920000935US1

2

BEST AVAILABLE COPY

PATENT
09/801,614

The Examiner admits that Schneck does not teach storing for each of said plurality of data files, a backup file inaccessible to user requests. However, the Examiner has failed to note that Schneck also fails to disclose reloading a backup file for each destroyed file.

Thus, while Schenck has a general concern with whether data found to be corrupted by unauthorized intrusion should be destroyed, the reference fully fails to disclose the either element in Applicants' novel combination solution in response to such an intrusion.

The teachings in Groshon fail to make up for these deficiencies in the basic Schneck patent. While the Examiner has pointed to general statements in Groshon related to backup data files, and the additional security offered by such files, Groshon still fails to suggest Applicants' aggressive response to a detected unauthorized intrusion into a data file: there is stored for each data file, a backup file which is inaccessible to any user requests. Then, as soon as an unauthorized intrusion is initially determined, the requested data file is immediately destroyed, and stored backup file is substituted for the destroyed files.

Actually, the general statements in Groshon could lead one skilled in the art away from making the Examiner's proposed combination of elements. For example, Groshon (at col. 5, lines 34-38) states that there may be circumstances where compromised and suspect data may be transmitted and

AUS920000935US1

3

BEST AVAILABLE COPY

PATENT
09/801,614

used. This certainly would lead one skilled in the art away from Applicants' immediate solution of immediate destruction of the intruded data file, and the substitution of the stored backup file.

What the Examiner has done is used Applicants' disclosure as a guideline, and the picked and combined elements from each of the two references based solely of Applicants' teaching.

"To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art references of record convey nor suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." W. L. Gore, 721 F 2d at 1553, 220 USPQ, pp. 312-313.

"One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." In re Fine, 5 USPQ 2d 1596 (C.A.F.C.) 1988.

Accordingly, it is submitted that the suggestion for combining Schneck with Groshon in the manner proposed by the Examiner could only come from Applicants' own teaching, and, thus, cannot form any basis for a combination of references.

Furthermore, even if the elements from Schneck and Groshon were to be combined in the manner suggested by Examiner, the combination would still lack significant elements of the combination of the present invention i.e. There is 1) stored for each data file, a backup file which is inaccessible to any user requests. Then, as soon as an

AUS920000935US1

4

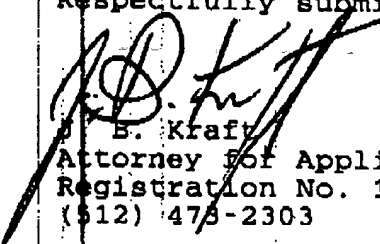
BEST AVAILABLE COPY

PATENT
09/801,614

2. unauthorized intrusion is initially determined, the requested data file is immediately destroyed, and stored backup file is substituted for the destroyed files.

In view of the foregoing, claims 1, 4, 5, 7, 10, 13, 14, 17, 20, 21, 24, 25, 27, and 30 are submitted to be in condition for allowance, and such allowance is respectfully requested.

Respectfully submitted,



J. B. Kraft
Attorney for Applicants
Registration No. 19,226
(512) 473-2303

PLEASE MAIL ALL CORRESPONDENCE TO:
Herman Rodriguez
IPLaw Dept. - IMAD 4054
IBM Corporation
11400 Burnet Road
Austin, Texas 78758

AUS920000935US1

5